

REMARKS

Applicant wishes to thank the Examiner for the attention accorded to the instant application, and respectfully requests reconsideration of the application as amended.

Formal Matters

Claims 1, 7, and 13 are the claims currently pending in the Application.

Applicant appreciates that the Examiner has reviewed the references submitted in the Information Disclosure Statement (IDS) filed with the application on March 25, 2004, and the IDS filed on August 9, 2004.

Specification

The Examiner objected to the disclosure because the status of Application Serial No. 09/602,229 needed to be updated. Accordingly, applicant amends the Cross Reference To Related Application section of the disclosure to state that Application Serial No. 09/602,229 is now U.S. Patent No. 6,775,416.

Rejection of Claims Under 35 U.S.C. §102

Claims 1 and 7 are rejected under 35 U.S.C. §102(e), as being anticipated by Conover, *et al.*, U.S. Patent No. 6,373,960 (hereinafter “Conover”). This rejection should be withdrawn based on the comments and remarks herein.

Among the problems recognized and solved by Applicant’s claimed invention is the need to increase the amount of information that can be inserted into DCT coefficient data. Applicant’s inventive solution eliminates variations in code length that occur when information is inserted, enabling insertion of a great deal of information into compressed digital image data. As recited in the claims, applicant’s invention prevents overall or total code length variations by changing at least one DCT coefficient of the

input DCT coefficients, and restoring or correcting the total code length by at least referring to a variable-length code table, so that the total code length of the resulting DCT coefficient is equal to the original total code length.

The Examiner contends that Conover discloses changing the sign of a DCT coefficient to produce changed DCT coefficients in an image block (col. 11, lines 32-37), and modifying the magnitude of a DCT coefficient in an image block (among changed DCT coefficients) so that total code length remains the same (col. 11, lines 37-43 and col. 12 lines 38-45), which allegedly reads on the first clause of claim 1. In addition, the Examiner alleges that Conover discloses that a modified DCT coefficient is corrected by prefixing zeroes onto a bit-pattern for a DCT coefficient so that total code length generated from the corrected DCT coefficient in an image block is identical to the total code length generated from the original DCT coefficients in the image block (col. 11, lines 51-56 and col. 17, lines 4-13), which the Examiner contends reads on the second clause of Claim 1.

Applicant respectfully disagrees. Conover merely discloses changing a particular DCT coefficient to another DCT coefficient having an equal number of bits, either by changing the sign or by changing the magnitude to another having the same number of bits. However, Conover does not disclose or suggest changing a DCT coefficient in a block to produce modified coefficients and then correcting a level of a DCT coefficient from the modified DCT coefficients, except the changed DCT coefficients, to produce corrected DCT coefficients. More specifically, Conover does not disclose or suggest changing the sign or the magnitude of a DCT coefficient followed by correcting a level of a DCT coefficient. In fact, Conover only discloses the changing of a DCT coefficient to

another DCT coefficient that has a number of bits that does not exceed the replaced DCT coefficient. In this regard, Conover discloses that when changing the magnitude of the DCT coefficient, zeroes may be prefixed to a chosen bit-pattern that has fewer bits to make sure that the number of bits is the same as the bit pattern of the DCT coefficient being replaced. Thus, Conover's prefixing is part of changing a particular DCT coefficient to another DCT coefficient of equal number of bits. Applicant respectfully asserts that prefixing zeroes does not represent a correction of a level of a DCT coefficient. Furthermore, Conover is concerned with number of bits being the same for only a particular DCT coefficient, but Conover is not concerned with selecting a DCT coefficient and correcting its level so that total code length of codes generated from the corrected DCT coefficients is equal to original code length generated from the input DCT coefficients. Hence, Conover does not disclose or suggest changing at least one DCT coefficient of the input DCT coefficients to produce changed DCT coefficients or correcting a level of a DCT coefficient selected from the changed DCT coefficients in the block, excluding the at least one changed DCT coefficient, to produce corrected DCT coefficients as recited in claims 1 and 7.

It has been held by the courts that "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). As illustrated above, Conover does not disclose changing at least one DCT coefficient of the input DCT coefficients to produce changed DCT coefficients or correcting a level of a DCT coefficient selected from the changed DCT coefficients in the block, excluding the at

least one changed DCT coefficient, to produce corrected DCT coefficients, so that Conover does not disclose every feature of the invention as recited in claims 1 and 7. Consequently, these claims are not anticipated by the art of record in the application. Accordingly, this rejection should be withdrawn.

Rejection of Claims Under 35 U.S.C. §103

Claim 13 is rejected under 35 U.S.C. §103 as being unpatentable over Conover. This rejection should be withdrawn based on the comments and remarks herein.

As discussed above, Conover does not disclose or suggest changing at least one DCT coefficient of the input DCT coefficients to produce changed DCT coefficients or correcting a level of a DCT coefficient selected from the changed DCT coefficients in the block, excluding the at least one changed DCT coefficient, to produce corrected DCT coefficients, so that Conover does not disclose or suggest every feature of the invention as recited in claim 13.

It has been held by the courts that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As illustrated above, Conover does not disclose or suggest each and every feature of the present invention as recited in claim 13. Thus *prima facie* obviousness has not been established.

Accordingly, claim 13 is distinguishable over the art of record in the application. Therefore, withdrawal of this rejection is kindly requested.

Conclusion

For at least the reasons set forth in the foregoing discussion, Applicant believes that the Application is now allowable and respectfully requests that the Examiner reconsider the rejections and allow the Application. Should the Examiner have any questions regarding this Amendment, or regarding the Application generally, the Examiner is invited to telephone the undersigned attorney.

Respectfully submitted,



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